

REMARKS

Claims 9 to 11, 13 to 17 and 19 to 26 are pending.

Reconsideration is respectfully requested based on the following.

Applicants thank the Examiner for withdrawing the previous claim objections and 35 U.S.C. § 112 rejections.

As to paragraph three (3), claims 9 to 11, 13, 14, 17, 19, 22, 23, and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,309,132 (“Jakob”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 9 is to “a self-locking bolt” and includes the features of “engagement surfaces for a tool at an end of the shank, *wherein the head has a bottom surface connecting the head to the shank and a top surface that is round and smooth.*” The “examiner maintains that the head (38) has a bottom surface (bottom of 38) connecting the head (38) to the shank and a top surface (top of 38) that is round and smooth (the bottom of 38 connects the head to the shank and the top of 38 is round and smooth).” Final Office Action at para. 7 (Nov. 24,

2008). As previously explained, the “top” surface of Jakob cannot be described as having a smooth surface because it has a hexagon shaped tool interface protruding out of it.

From the online dictionary selected by the Office, the word “smooth” has a first definition of “free from projections or unevenness of surface; not rough.” (<http://wordnet.princeton.edu/perl/webwn?s=smooth>). *The surface of the head, which is not attached to the shank, is clearly not “free from projections,” as the tool interface is projecting from it. Thus, neither surface of “Jakob” is a “smooth surface.”*

The Office has yet to explain how the top surface -- with a hexagon shaped tool interface protruding out of it -- is “smooth.” *If the tool interface is considered affixed to the top surface (e.g., not part of the top surface), then the top surface is clearly not “smooth,” as a large tool interface is protruding out of it. If the tool interface is considered part of the top surface, then the top surface is clearly not “smooth,” as the six hexagon edges protrude from the interface shape. Accordingly, “Jakob” does not identically disclose (nor even suggest) all of the features of claim 9, as presented, so that it is allowable.*

Claims 10, 11, 13, 14, 17, 19, 22, 23, and 26 depend from claim 9, and are therefore allowable for at least the same reasons.

As regards paragraph six (6), claims 15, 16, 20, 21, 24 and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over “Jakob” in view of EP 0747604.

Claims 15, 16, 20, 21, 24 and 25 depend from claim 9, as presented, and are therefore allowable for the same reasons, since any review of the secondary reference makes plain that it does not cure -- and it not asserted to cure -- the critical deficiencies of the primary reference.

Accordingly, claims 9 to 11, 13 to 17 and 19 to 26 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of claims 9 to 11, 13 to 17 and 19 to 26 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

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